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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,513	03/10/2004	Kazuhiro Yasuda	14470.31US01	8757

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HAMRE, SCHUMANN, MUELLER & LARSON, P.C.
P.O. BOX 2902-0902
MINNEAPOLIS, MN 55402

EXAMINER	
MCMAHON, MARGUERITE J	

ART UNIT	PAPER NUMBER
3747	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,513	YASUDA ET AL.	
	Examiner	Art Unit	
	Marguerite J. McMahon	3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/17/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,7,10,13,15 and 18-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 4, 7, 10, 13, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostun (6,427,112) in view of Hirano et al (6,655,337). Note Figure 8 of Kostun, which shows a first resonator 146 and a second resonator 152, air cleaner 148, and throttle body 156. Kostun shows everything except utilizing a carburetor, disposing the first and second resonators within a width of the air cleaner case, locating the intake pipe and connection pipe on the same side of the air cleaner case, orienting the device such that it faces forwardly in the vehicle, locating the resonators such that they are each disposed on the same side of the intake pipe and connection pipe, and employing the device in an off-road vehicle.

Hirano et al (6,655,337) teaches that it is old in the art to substitute a carburetor for a throttle body (see column 2 , lines 16-18). It would have been obvious to modify Kostun by replacing the throttle body 156 with a carburetor, in order to change the engine from the fuel injection type into a carburetor type, as these are art recognized alternatives, known for the same purpose of providing fuel to the engine.

In addition, it would have been obvious to one having ordinary skill in the art to modify Kostun by locating the intake pipe and connection pipe on the same side of the air cleaner case and to orient the device such that it faces forwardly in the vehicle, since it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse, 86 USPQ 70. This sort of change would be indicated in applications where space considerations apply, which is a common motivation for a rearrangement of parts.

Furthermore, it would have been obvious to one of ordinary skill in the art to dispose the first and second resonators within a width of the air cleaner case, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). See Figure 8 of Kostun shown below, and as seen from the Figure, a slight shift in the shape or location of the first resonator would enable the resonator to fit within the width of the air cleaner case. This would be indicated in applications where space considerations apply, which is a common motivation for an adjustment.

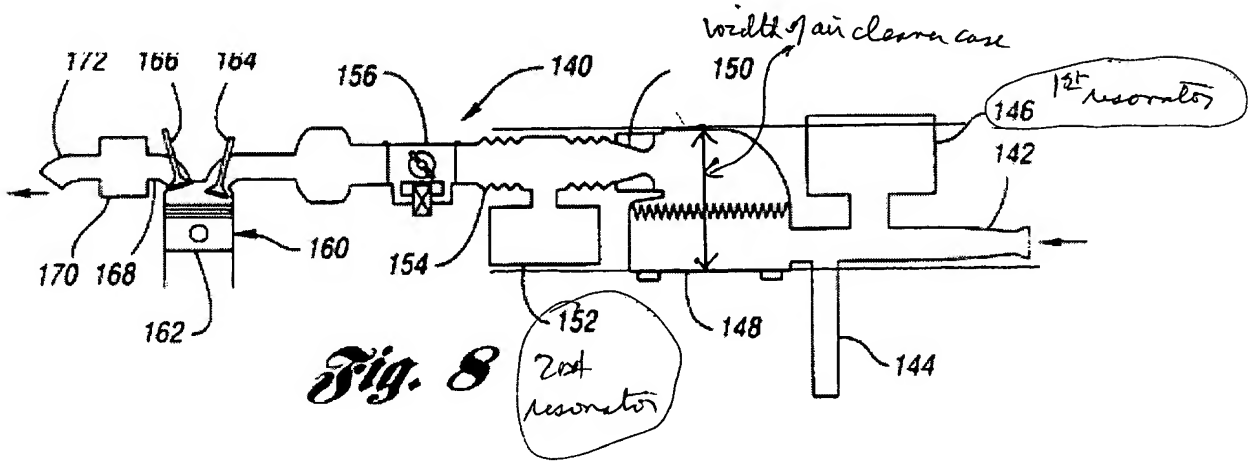

Fig. 8

In addition, it would have been obvious to one of ordinary skill in the art to locate the resonators such that they are each disposed on the same side of the intake pipe and the connection pipe in lieu of being located on opposite sides, as shown above, since it appears that the device would function equally well in either case, and the arrangement is merely one of expedience in terms of the spacial parameters of the particular engine application. Note also that it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse, 86 USPQ 70.

Finally, it would have been obvious to one having ordinary skill in the art to employ the device in an off-road vehicle, as this is a conventional use for an internal combustion engine.

Response to Arguments

Applicant argues that the newly added feature of the location of the intake pipe and the connection pipe extending from the same side of the air cleaner case is a patentable distinction over the prior art. The examiner does not find this convincing. In engine applications where space can be better utilized by locating the two ducts on the same side of the air cleaner case, it would have been within the purview of one of ordinary skill in the art to rearrange the parts of the invention by locating the two ducts on the same side of the air cleaner case. As noted above, it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse, 86 USPQ 70.

Applicant further argues that Hirano does not teach an intake device where an intake pipe and a connection pipe extend from the same side of an air cleaner case. Since Hirano has not been relied upon to show this feature, this argument is moot.

Applicant further argues that locating the resonators within the width of the air cleaner case is only motivated by impermissible hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As noted in the above rejection, a slight shift in the shape or location of the first resonator would enable the resonator to fit within the width of the air cleaner case. This would be indicated in applications where space considerations apply, which is a common motivation for an adjustment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marguerite J. McMahon whose telephone number is 571-272-4848. The examiner can normally be reached on Monday-Wednesday and Friday, 10am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Cronin can be reached on 571-272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MARGUERITE MCMAHON
PRIMARY EXAMINER